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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,265	01/27/2004	Eric Rodney DeBeer	ADAM / 25	9572
<div>7590 07/17/2007 Keith R. Haupt Wood, Herron & Evans, L.L.P. 2700 Carew Tower Cincinnati, OH 45202</div>			<div>EXAMINER GATES, ERIC ANDREW</div>	
			<div>ART UNIT 3722</div>	<div>PAPER NUMBER</div>
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/765,265

Applicant(s)

DEBEER ET AL.

Examiner

Eric A. Gates

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 19-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-16, and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to Applicant's amendment filed 9 April 2007.

Drawings

1. New drawings were received on 9 April 2007. These drawings are acceptable.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12-16 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 12 recites the limitation "a feed means for feeding an end of the sheet of paper to be bound into a partially folded binding strip which defines a longitudinal axis, the folded binding strip having two portions angularly disposed to each other about a fold line, in a direction parallel to the longitudinal axis of the binding strip". It is unclear from the claim whether the "direction parallel to the longitudinal axis of the binding strip" applies to the direction of feed for the sheet of paper or the direction of the fold line of the binding strip. For the purposes of examination, the parallel direction has been assumed to apply to the latter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 12-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffman (U.S. Patent Publication 2002/0164230 A1).

7. Regarding claim 12, Hoffman discloses an apparatus 10 for binding a sheet of paper, which includes: a feed means 20 for feeding an end 24 of the sheet of paper 14 to be bound into a partially folded binding strip 22 which defines a longitudinal axis, the folded binding strip having two portions angularly disposed to each other about a fold line (as shown in figures 6-11 of incorporated reference U.S. Patent 2,042,912), in a direction parallel to the longitudinal axis of the binding strip (the fold line being in a direction parallel to the longitudinal axis of the binding strip); and a reciprocating securing means 16 for securing the binding strip to the end of the sheet of paper, wherein the feed means directs the end 24 of the sheet of paper toward the binding strip prior to securing the binding strip to the end of the sheet of paper with the reciprocating securing means (see figure 2, direction A).

8. Regarding claim 13, Hoffman discloses the securing means 16 folds or crimps the binding strip 22 (see paragraph [0029]).

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9. Regarding claim 14, Hoffman discloses a supply means for supplying the binding strips 22 (per paragraph [0029], system 10 automatically processes a supply of workpieces 14 with slides 22, 22a without requiring operator involvement).

10. Regarding claim 15, Hoffman discloses forming equipment for forming the binding strips from a supply of metal (as disclosed in incorporated reference U.S. Patent 2,042,912).

11. Regarding claim 16, Hoffman discloses a displacement means 26a for displacing the sheet of paper after the binding strip has been bound thereto, in a direction B parallel to the feeding direction A.

12. Regarding claim 18, Hoffman discloses a second feed means 30 for feeding an opposed end of the sheet of paper 14 into a further binding strip 22a.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman (U.S. Patent Publication 2002/0164230 A1) in view of Debrunner et al. (U.S. Patent Publication 2002/0021951 A1).

15. Regarding claim 1, Hoffman discloses a method (see figure 2) of binding a sheet of paper 14 which includes the steps of: feeding an end of a sheet of paper 14 to be

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bound into a partially folded elongate binding strip 22 which defines a longitudinal axis and has two portions angularly disposed to each other (as shown in figures 6-11 of incorporated reference U.S. Patent 2,042,912), the end of the sheet of paper being fed in a feed direction that is perpendicular to the longitudinal axis of the binding strip into a region between the two portions; and mating the end of the sheet of paper and the binding strip, with the end of the sheet of paper located in the region between the two portions.

Hoffman does not disclose that the sheet of paper is fed in a feed direction that is parallel to the longitudinal axis of the binding strip into a region between the two portions. Debrunner et al. teaches a method of binding in which a sheet of paper 3 is fed in a feed direction that is parallel to the longitudinal axis of a binding strip 8 with two portions (not labeled, see figure 2) that extend beyond the spine 5 of the sheet of paper 3 for the purpose of aligning the sheet of paper 3 with the binding strip 8 prior to pressing. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the method of Hoffman with the feed direction of Debrunner et al. in order to have a binding system that flows in a straight path from contact of the paper with the binding strip to the pressing step.

16. Regarding claim 2, the modified invention of Hoffman discloses the step of securing the end of the sheet of paper between the two portions, by a reciprocating operation (while not disclosed distinctly, the act of folding and crimping the binding strip would inherently involve a reciprocating action).

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17. Regarding claim 3, the modified invention of Hoffman discloses the steps of folding and crimping the binding strip (see paragraph [0029]).

18. Regarding claim 4, the modified invention of Hoffman discloses the prior step of locating the end of the sheet of paper at an edge of the binding strip between the two portions to facilitate feeding thereof into the binding strip (see paragraph [0029]).

19. Regarding claim 5, the modified invention of Hoffman discloses the prior step of forming the binding strip (as disclosed in incorporated reference U.S. Patent 2,042,912).

20. Regarding claim 6, the modified invention of Hoffman discloses the steps of: providing a length of metal workpiece; folding the length of metal workpiece about a fold line parallel to a longitudinal axis thereof to form the two portions to be angularly disposed to each other about the fold line (as disclosed in incorporated reference U.S. Patent 2,042,912).

21. Regarding claim 7, the modified invention of Hoffman discloses the further step of binding an opposed end of the sheet of paper, the opposed end being parallel to the bound end (see paragraph [0029] and figure 2).

22. Regarding claim 8, the modified invention of Hoffman discloses that after the first end of the sheet of paper 14 has been secured to a first binding strip 22, the steps of displacing the sheet of paper and the first binding strip secured thereto, in a direction B parallel to the feed direction A, and binding the opposed end of the sheet of paper with a second binding strip 22a.

23. Regarding claim 10, the modified invention of Hoffman discloses moving the sheet of paper transversely (direction C) to the feed direction.

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24. Regarding claim 11, the modified invention of Hoffman discloses securing the opposed end of the sheet of paper in the second binding strip 22a by a reciprocating operation (while not disclosed distinctly, the act of folding and crimping the binding strip would inherently involve a reciprocating action).

Response to Arguments

25. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

26. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Therefore, applicant's argument that Debrunner et al. does not teach "feeding of the sheet of paper toward a binding strip" is not applicable because Debrunner et al. was not relied upon for this teaching. Debrunner et al. instead teaches a method of binding in which a sheet of paper is fed in a feed direction that is parallel to the longitudinal axis of a binding strip.

27. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation for feeding the sheet of paper in a direction parallel to the longitudinal axis of the binding strip is taught in Debrunner et al.

28. Counsel's statements regarding the suitability of the combination of Hoffman and Debrunner et al. are not factually supported and appear to be speculative in nature. Note that the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). See also MPEP section 716.01(c), for example.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:45-6:15.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EAG
29 June 2007



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SUPERVISORY PATENT EXAMINER